

### **Remarks**

The Office Action dated November 12, 2009 has been carefully considered. Claims 1, 13, and 16 have been amended and claims 21-24 have been newly added without the addition of new matter. Claims 6 and 20 have been canceled. Reconsideration of the current claims in view of the following remarks is respectfully requested.

### ***Information Disclosure Statement***

The Attorney for Applicant acknowledges paragraph 1 of the Office Action and the status of the Information Disclosure Statement filed 08/24/06, and that this IDS has been placed in the file, but has not been considered. Abeyance is requested on this matter until a concise explanation can be provided.

### ***Claim Rejections – 35 USC § 103***

In Paragraph 5 of the Office Action, claims 1-6, 8, 14-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Worschech et al. (US 3,875,069) (referred to as ‘069) in view of Worschech et al. (4,637,887) (referred to as ‘887).

The ‘069 and ‘887 references have been considered in view of the factual inquiries set forth in *Graham v. John Deere Co.*, and, in particular, the following is a summary of the scope and content of the ‘069 and ‘887 references, and the differences between the ‘069 and ‘887 references and the current claims at issue.

The present invention is directed to lubricant combinations for thermoplastics comprising a) natural fats and oils with iodine values below 10, and b) standard lubricants for thermoplastics which are different from a) for thermoplastic polymers wherein the fats and oils of a) can be used

in the form of naturally occurring fats and oils, or the hydrogenation products thereof, and wherein the lubricant b) is selected from fatty acid ester of fatty alcohols, dicarboxylic acid esters of fatty alcohols, polyol fatty acid ester, and mixtures thereof.

The '069 patent discloses a lubricant composition for shaping thermoplastics wherein the lubricant composition includes (A) mixed esters and (B) esters selected from the group consisting of (1) esters of phthalic acid and alkanols of 12 to 30 carbons and (2) partial esters of glycerin and aliphatic hydrocarbon monocarboxylic acids having 12 to 30 carbon atoms and mixtures of partial esters of glycerin and hydroxyalkanoic acids having 12 to 30 carbon atoms and triglycerides of hydroxyalkanoic acids having 12 to 30 carbon atoms, with a ratio of (A) to (B) being 1:3 to 9:1. The '069 patent does not disclose the lubricant set forth in component (b) of the current claims.

The '887 patent discloses a lubricant composition comprising a "...molding lubricant consisting essentially of triglycerides containing hydroxyl fatty acid residues obtained by hydrogenating at least one epoxidized natural fat or oil selected from..." (claim 1). According to the '887 patent, the triglycerides containing hydroxyl fatty acid residues are obtained by a chemical reaction from natural fats and oils as starting materials (col 1, line 65 ff.). These natural fats and oils are first epoxidized (col 2, line 3), and subsequently hydrogenated (col 2, lines 9-19).

In conclusion, the triglycerides of the '887 patent are not natural fats and oils, as set forth in the present claims. Moreover, the '887 patent teaches away from the present claims. According to column 1, lines 51-52, the triglycerides of the '887 patent "may be used as a substitute for hardened castor oil." However, the natural fats and oils of the present invention are employed as a substitute for esters of phthalic acid (example C, B3, and B5 of the present

application, page 13). Hence, the '887 patent discloses substituting another type of compound in a lubricant composition. Based on the foregoing factual inquiries, the rejection of claims 1-6, 8, 14-18, and 20 under 35 U.S.C. 103(a) as being unpatentable over the '069 patent in view of the '887 patent has been rebutted, and it is respectfully requested that this rejection be withdrawn.

In Paragraph 6 of the Office Action, claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Worschech et al. (referred to as '069) in view of Worschech et al. (referred to as '887) as applied to claims 1-6, 8, 14-18, and 20 above, and further in view of Haack et al. (US 5,889,102). Since claim 9 is dependent on claim 1, the foregoing remarks regarding the '069 and '887 references apply herein. Haack et al. discloses that pentaerythritol tetrastearate is a known lubricant for use in combination with other lubricants for use with plastics. However, combining this fact with the '069 and '887 patents fails to disclose the present invention set forth in the current claims as set forth in the foregoing remarks for the rejection of claim 9. Based on the foregoing factual inquiries, the rejection of claim 9 under 35 U.S.C. 103(a) as being unpatentable over the '069 patent in view of the '887 patent in view of Haack et al. has been rebutted, and it is respectfully requested that this rejection be withdrawn.

In Paragraph 7 of the Office Action, claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Worschech et al. (US 3,875,069) (referred to as '069) in view of Worschech et al. (4,637,887) (referred to as '887) as applied to claims 1-6, 8, 14-18, and 20 above, and further in view of Dohi et al. (US 2004/0014861A).

Since claim 10 is dependent on claim 1, the foregoing remarks regarding the '069 and '887 references apply herein. Dohi et al. discloses a material useful in the molding of polycarbonate material which uses dipentaerythritol hexastearate. However, combining this fact with the '069 and '887 patents fails to disclose the present invention set forth in the current

claims as set forth in the foregoing remarks for the rejection of claim 10. Based on the foregoing factual inquiries, the rejection of claim 10 under 35 U.S.C. 103(a) as being unpatentable over the '069 patent in view of the '887 patent in view of Dohi et al. has been rebutted, and it is respectfully requested that this rejection be withdrawn.

In Paragraph 8 of the Office Action, claims 7 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Worschech et al. (US 3,875,069) (referred to as '069) in view of Worschech et al. (4,637,887) (referred to as '887) as applied to claims 1 and 6 above, in view of Dohi et al. (US 2004/0014861A) as applied to Claim 10, in view of Haack et al. as applied to Claim 9, and further in view of Lindner (US 6,818,689).

Since claims 7 and 11-13 are dependent on claim 1, the foregoing remarks regarding the '069 and '887 references apply herein. Lindner discloses a lubricant composition for use in the processing of polyvinyl chloride comprising an ester of a monofunctional organic acid and a monohydric alcohol wherein the ester is stearyl stearate. However, combining the disclosures of the '069 and '887 patents fail to disclose the present invention as set forth in the current claims, which has been previously discussed in the remarks for the rejection of claims 1-6 on pages 5-7 above. Based on the foregoing factual inquiries, the rejection of claims 7 and 11-13 under 35 U.S.C. 103(a) as being unpatentable over the '069 patent in view of the '887 patent in view of Dohi et al. in view of Haack et al., and further in view of Lindner has been rebutted, and it is respectfully requested that this rejection be withdrawn.

At the end of Paragraph 8 of the Office Action, claim 19 is discussed. However, the Office Action does not clearly state the grounds for rejection or the references the Office Action relies upon for such a rejection. The section discusses Worschech et al. (US 3,875,069) (referred to as '069) as it applies to the limitations of claim 19. As such, Applicants direct their response

to the supposed rejection of claim 19 under 35 U.S.C. 103(a) as it may relate to '069. If the Office Action was to state other grounds for rejection, Applicants respectfully request an opportunity to be heard on such grounds..

Since claim 19 is dependent on claim 16, the foregoing remarks regarding the '069 reference applies herein. Based on the foregoing factual inquiries, the rejection of claim 19 under the assumed grounds of 35 U.S.C. 103(a) as being unpatentable over the '069 patent has been rebutted, and it is respectfully requested that this rejection be withdrawn.

### ***Conclusion***

In view of the amendments and remarks presented herein, Applicant submits that the present application is in condition for allowance, and such action is respectfully requested. If, however, any issues remain unresolved, the Examiner is invited to telephone Applicant's counsel at the number provided below.

Respectfully submitted,

/Philip P. McCann/

Philip P. McCann  
Registration No. 30,919

SMITH MOORE LEATHERWOOD LLP  
P.O. Box 21927  
Greensboro, NC 27420  
(336) 378-5302  
phil.mccann@smithmoorelaw.com

Date: February 11, 2010

File No.: 5007447.010US1

#### **CERTIFICATE OF TRANSMISSION**

I HEREBY CERTIFY THAT THIS DOCUMENT IS BEING TRANSMITTED VIA EFS-WEB TO THE UNITED STATES PATENT AND TRADEMARK OFFICE ADDRESSED TO: MAIL STOP AMENDMENT, COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450, ON February 11, 2010  
(Date)

Lorna D. Selvaggio  
Name of Depositor

/Lorna D. Selvaggio/  
Signature

February 11, 2010  
Date of Signature